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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,856	04/21/1999	TODD R. COLLART	IA 1506.01A US	7668

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DISCOVISION ASSOCIATES  
INTELLECTUAL PROPERTY DEVELOPMENT  
2355 MAIN STREET, SUITE 200  
IRVINE, CA 92614

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/295,856

**Applicant(s)**

COLLART, TODD R.

**Examiner**

Paul L Rodriguez

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21,47,50-53,56-59,62-65,68-71 and 74-81 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 79-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47,50-53,56-59,62-65,68-71 and 74-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/04 has been entered.

2. The amendment filed 9/30/04 has been received and considered. Claims 21, 47, 50-53, 56-59, 62-65, 68-71 and 74-81 are presented for examination. Claims 21 and 79-81 have been withdrawn from consideration.

### *Claim Objections*

3. Claims 53, 59 and 71 are objected to because of the following informalities:

Claim 53 line 8 recites "the identifier incorporated on the BCA", previously "an identifier on a burst cut area", there was no previous recitation of incorporating or incorporation. Reference to the same limitations should remain consistent to avoid any confusion or possible antecedent problems. Would be better as "the identifier on the BCA".

Claim 59 lines 9-10 recites "the identifier incorporated on the BCA", previously "an identifier on a burst cut area", there was no previous recitation of incorporating or incorporation. Would be better as "the identifier on the BCA".

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Claim 71 lines 9-10 recites “the identifier incorporated on the BCA”, previously “an identifier read from said optical storage medium on a burst cut area”, there was no previous recitation of incorporating or incorporation. Would be better as “the identifier read from said optical storage medium on the BCA”.

Appropriate correction is required.

4. The examiner has provided a number of examples of the claim deficiencies in the above, however, the list of deficiencies may not be all inclusive. Applicant should refer to these as examples of deficiencies and should make all the necessary corrections to eliminate the claim objections.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 47,50-53,56-59,62-65,68-71, 74 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Uranaka et al (U.S. Pat 6,470,085). The claimed invention reads on Uranaka et al as follows, (like or similar limitations have been grouped together):

Uranaka et al discloses (claim 47, 59, 71) a method for providing selective access to data on an optical storage medium (abstract, col. 1 lines 9-15, col. 4 lines 46-65), (claim 47, 59)

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receiving an identifier (reference number 30, col. 5 lines 58-62) incorporated on a burst cut area (BCA) (figure 2, 4) on said optical storage medium in conjunction with said data (reference numbers 21, 22, 24, figure 2, col. 4 lines 25-31, col. 5 line 58 – col. 6 line 13), (claim 47, 59) receiving pertinent user information ( $PK_u$ , reference number 32, reference number 35, col. 6 line 66 – col. 7 line 9), (claim 47, 59, 71), verifying said identifier and said pertinent user information at a database (col. 7 line 54 – col. 8 line 41), determining one of a replicator, distributor and retailer for the identifier incorporated on the BCA (col. 5 line 21 – col. 6 line 5, col. 14 line 59 – col. 15 line 3, the BCA contains volume ID ( $VID_v$ ) and volume issue number ( $NO_{v-i}$ ), both incorporated in the BCA at time of purchase. The process depicted and discussed in reference to figure 20c, uses a server 8, which provides a proper key after receiving the specific  $VID_v$  and  $NO_{v-i}$  recorded in the BCA, the server performs a lookup procedure based upon the information in the BCA, the BCA contains data/information specifically related to the purchase of the medium. Because the data recorded in the BCA is specific to the medium and the sale of the medium, the server inherently determines one of a distributor and retailer), (claim 47, 59, 71) tailoring a response based on a pre-defined condition (col. 8 line 42 – col. 16 line 46, figures 5-20, based on the terms of use, access is either provided or not), and (claim 47, 62), passing the response to a remote location (response from server to client, where client is remote from server), (claim 50, 63, 71) wherein the response is an authorization for an access to data stored on said optical data storage (reference numbers 650, 700, 800 of figures 5 with description), (claim 51) wherein said identifier incorporated on said optical storage medium is performed by a content provider (inherent, col. 1 lines 16-20, col. 5 lines 31-42), (claim 52, 64) wherein said data comprises multimedia data (col. 4 lines 46-65, CD-ROM, DVD), (claim 71) comprising

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receiving at a server computer (reference number 8) an identifier information read from said optical storage medium on a burst cut area (BCA) (reference number 23, 30, 35, figure 4, 5), wherein said identifier information identifies a specific instance of said optical storage medium (reference number 30), receiving at a server computer pertinent user information (col. 6 lines 50-51, 58-63), verifying said identifier information and pertinent user information using a database (figure 6a, col. 7 line 54 – col. 8 line 33), transmitting said response to a remote location (col. 7 lines 54-57, authorization sent from server to client is considered transmitting), (claim 74) wherein the identifier information is updated and stored in a BCA database (reference number 60, figure 6a) (claim 75), broadcasting one of the identifier information and the updated identifier information (col. 7 lines 54-57, information sent to and from the server and client is considered broadcasting), (claim 53) a system for providing selective access to data on an optical storage medium (figure 1), comprising a first receiver for receiving an identifier on a burst cut area (BCA) on said optical storage medium (reference number 130, col. 6 lines 51-54, 58-63), a second receiver for receiving pertinent user information (reference number 120, col. 6 lines 50-51, 58-63), said pertinent user information and said identifier being verified at a database (col. 7 line 54 – col. 8 line 41), and a response generator (server) for tailoring a response to be sent to a remote location (client, col. 8 line 42 – col. 16 line 46), said response being based on a pre-defined condition (col. 8 line 42 – col. 16 line 46), (claim 56) wherein said receivers are located in one location (reference number 2), (claim 57) wherein said response is passed to a remote location (response from server to client, client is remote from server), (claim 58, 70) wherein said data comprises multimedia data (col. 4 lines 46-65, inherent CD-ROM and DVD), (claim 65) a system for providing selective access to data on an optical storage medium (figure 1),

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comprising a receiver (reference number 130) for receiving pertinent user information (PK<sub>u</sub>, reference number 32, col. 6 line 66 – col. 7 line 9) and an identifier (reference number 30) incorporated on a burst cut area (BCA) (reference number 23) in conjunction with said data (reference numbers 21, 22, 24, figure 2), a verifier to verify said identifier at a separate database (reference number 8) and a response generator for tailoring a response to be sent to a remote location, said response being based on a pre-defined condition (col. 8 line 42 – col. 16 line 46), wherein said source is a content provider (inherent, col. 1 lines 16-20, col. 5 lines 31-42), (claim 69) wherein said response is an authorization for an access to data stored on said optical data storage (reference numbers 650, 700, 800). Examiner would like to point out that any reference to specific figures, columns and lines should not be considered limiting in any way, the entire reference is considered to provide disclosure relating to the claimed invention.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 47, 50-53, 56-59, 62-65, 68-71, 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka et al (U.S. Pat 6,470,085) in view of Oshima et al (U.S. Pat 6,081,785).

Uranaka et al teaches most all of the instant invention as applied to claims 47, 50-53, 56-59, 62-65, 68-71, 74 and 75 above.

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Uranaka et al fails to teach determining one of a replicator for the identifier incorporated on the BCA.

Oshima et al teaches optical disks, optical recorder and optical reproducer that utilize a BCA for recording different IDs for individual disks in a factory, and using those specific IDs to provide access to the content of the disks (abstract, figure 6a-b) and determining one of a replicator (811) for the identifier incorporated on the BCA (815, 833a, col. 4 line 39 – col. 5 line 34)

Uranaka et al and Oshima et al are analogous art because they are both related to the production, distribution and protection of content on an optical storage medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize an ID recorded in the BCA of Oshima et al in the system and method for providing selective access to data of Uranaka et al because it is well known that serial numbers, ID numbers, batch numbers etc. are used by manufactures to identify specific products they produce and the particular numbers are used to track, inventories, distribution and quality of those products and Oshima et al teaches simplified access to content on an optical storage medium (col. 1 lines 27-50) while improving security of information (col. 18 lines 58-67).

9. Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka et al (U.S. Pat 6,470,085) in view of Brindze et al (U.S. Pat 5,822,291).

Uranaka et al teaches most all of the instant invention as applied to claim 71 above. Uranaka et al fails to teach (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer, (claim 77) further



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comprising providing a logic to control access to a web site, the logic being based on the identifier information stored on the BCA and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer.

Brindze et al teaches (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer (col. 8 lines 39 – col. 9 line 8, examiner considers "buy me" as anticipated by the "enhanced multimedia format" and purchasing) and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer (col. 9 lines 1-5).

Uranaka et al and Brindze et al are analogous art because they are both related to the distribution of multimedia on optical storage mediums.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the web and retailer access of Brindze et al in the system and method for providing selective access to data of Uranaka et al because Brindze et al teaches that their invention is directed to a multimedia transaction system that is particularly effective, versatile, inexpensive, and easy to use (col. 3 lines 20-22).

### ***Response to Arguments***

10. Applicant's arguments filed 9/30/04 have been fully considered but they are not persuasive.

Regarding the previous rejection under 35 U.S.C. 112, the amendment to the claims has corrected the previously cited deficiencies. However, deficiencies remain in the claims. See the above objections.

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Regarding the art rejections. The applicant argues that Uranaka does not disclose or render obvious determining one of a replicator, distributor, and retailer for the identifier incorporated on the BCA. Examiner would like to point out that the claim language states, “determining one of”, therefore the art only has to teach or disclose one of a replicator, distributor, and retailer. The Examiner relies upon the discloser of Uranaka et al to provide various support for the Examiners position. First Uranaka et al teaches that specific identifying information, the distribution descriptor 23, is recorded in the BCA at a point of sale in col. 5 line 21 – col. 6 line 41. It is the Examiners position that the information recorded in the BCA provides adequate information for the identification of the distributor or retailer that sold the electronic storage medium, “a volume issue number ( $NO_{v-i}$ ) 30 which contains a serial number given to each of the distributed application packages...in order of distribution...31 the data of which is given by the server 6 at a toll center of the provider...and sales date and time...are recorded...at the time of distribution...at the time of sales of the DVD 3”. It is the Examiners position that this disclosure provides adequate support for distributor or retailer identifier information on the optical storage medium. Uranaka et al goes on to disclose in reference to figure 20C that a user obtains a key from a remote server 8, using information by “...reading the  $PK_u$  field of the record which contains  $VID_v$  and  $NO_{v-i}$ ”. It is the Examiners position that because the server utilizes  $NO_{v-i}$  in order to provide the proper key to the user, the server makes a determination based upon the distributor and retailer information stored in  $NO_{v-i}$  and therefor determines one of a distributor and or retailer incorporated in the BCA. Applicant’s arguments to the contrary are not persuasive and the rejection is maintained.

Regarding the rejection under 35 U.S.C. 103. Applicant argues that “there is nowhere in Brindze that discloses a “buy me” button”. It is the Examiners position that based upon the claim language only “one of an e-commerce transaction and a ‘buy-me’ button are required to support the rejection of this limitation by the prior art. The Examiner relies upon the Brindze et al teaching found in col. 8 line 39 – col. 9 line 8 that clearly teaches using a optical storage medium, permitting a user access to content for shopping, the user can place an order, determine pricing and complete a sale using the computer system. It is the Examiners position that this teaching clearly provides support for at least the limitation of “an e-commerce transaction”, therefore supporting the rejection of the claims in question. Applicant’s argument that Brindze et al does not specifically disclose a “buy me” button is not persuasive because the use of icons in a graphical user interface for electronic shopping are well known and would have been obvious to include.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Floyd et al (U.S. Pub) 2002/0161709) – teaches a graphical user interface on a users machine, that utilizes an optical storage medium for electronic commerce that depicts a “buy me” screen and specifically “user clicks buy”.

Sloane et al (U.S. Pat 6,434,530) – teaches a user interface apparatus with a “Buy me” command function.

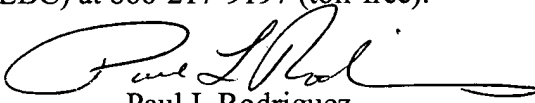
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (571) 272-3753.

The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul L Rodriguez  
Primary Examiner  
Art Unit 2125

PLR  
12/2/04